

REMARKS

I. Introduction

Applicant appreciates the thorough examination of the applicant's reply that was manifested in the Office action of 13 June 2003 (Paper 3). Claims 1-50 are currently pending in the present application. In view of the foregoing arguments, applicant respectfully submits that the Office action be reconsidered.

II. Claim rejections under 35 USC § 102

A. Claim 22 was rejected under 35 U.S.C. § 102(b) as being anticipated over Wiener (US Patent No. 6,490,521). As the Office action puts it, "*Wiener discloses an alert system comprising:*

- a. A condition information receiver 70, 71, 77 receiving condition data and generating condition information signal in response to the condition data*
- b. A positioning receiver 25 receiving position data and generating a position signal in response to the position data*
- c. A video system 81*
- d. An audio system 83*
- e. A system controller 76 electrically coupled to the condition information receiver 77, the positioning system receiver, the video system, the audio system, the system controller in response to the condition information signal (weather, traffic, navigation information, etc... col. 8, second paragraph) and the position signal (GPS data) forming an overlay condition position signal (col. 6, lines 32-40)."*

Applicant respectfully disagrees.

First, reference numeral 77 seems actually to be used in Wiener for GPS receiver. Reference numerals in Wiener start at 31, therefore there seems to be no reference numeral 25 in Wiener, the above remark of inconsistencies having to be applied to the references to Wiener with regard to claim 1, and, to a lesser extent, to claims 50 and 26 in the Office action.

Second, in the respective portion of the specification (column 6, lines 24-48 including those cited in the Office action), Wiener reads:

*"Map information received from service provider 31 and routed by central processing and data storage unit 76 to map data parser 79 may be represented in terms of geographical coordinates, and comprises specific coordinate locations corresponding to waypoints along a prescribed route. Map data parser 79 converts this map information so that display generation unit 80 can process the converted information, producing a visual representation of a map depicting the waypoints along the prescribed route. Display generation unit 80 also receives from map data parser 79 the current position of subscriber unit 35, as provided by position information parser 78. **As such, display generation unit 80 overlays the current position of subscriber unit 35 on the visual representation of the map. In other embodiments, destination information, traffic information, and weather information may be superimposed on the map.***

Display generation unit 80 drives display unit 81, which is an output device in navigation system 100. In a car, display unit 81 may comprise a windshield heads-up display or dashboard-mounted LCD. In other embodiments of subscriber unit 35, a compact LCD display may be integrated into a handheld assembly. Instead of displaying a map, display generation unit 80 may display in textual form a list of the instructions that a subscriber should follow along a route to an intended destination." (Emphasis added)

The above-cited information is the only portion of the Wiener's detailed description where "overlay" and "superimpose" occur. Contrary to the applicant's invention, Wiener does not appear to describe a system controller, which, in response to the condition information signal AND the position signal forms an overlay condition position signal.

For this reason, novelty of claim 22 is not believed to be shaken by Wiener, and applicant respectfully submits that the 35 U.S.C. § 102(b) rejection of claim 22 be withdrawn and claim 22 be allowed.

B. It is understood, though not explicitly formulated in the Office action, that claim 50 was also rejected under 35 U.S.C. § 102(b) as being anticipated over Wiener (US Patent No. 6,490,521). As the Office action puts it with regard to claim 50, *"Wiener discloses an alert system comprising a condition information receiver 70, 71, 77 receiving condition data and generating a condition information signal in response to the condition data, and an indicator. Wiener also discloses a system controller 76 electrically coupled*

to the condition information receiver 77, the positioning system receiver, the video and audio system, wherein the system controller in response to the condition information signal (weather, traffic, navigation information, etc... col. 8, second paragraph) and the position signal (GPS data) forming an overlay condition position signal and indicates the overly condition position signal on the video and audio system. Col. 6, lines 33-49."

Based on the above arguments with regard to the novelty of claim 22, Wiener does not appear to describe a system controller, which, in response to the condition information signal AND the position signal forms an overlay condition position signal.

For this reason, novelty of claim 50 is similarly not believed to be destroyed by Wiener, and applicant respectfully submits that the 35 U.S.C. § 102(b) rejection of claim 50 be withdrawn and claim 50 be allowed.

III. Claim rejections under 35 USC § 103

Claims 1-21 and 23-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiener (US Patent No. 6,490,521) in view of Maxwell et al (US Patent No. 5,635,921).

For independent claim 1, the Office action asserts that "*Wiener discloses an alert system comprising:*

- a. A condition information receiver 70, 71, 77 receiving condition data and generating a condition information signal in response to the condition data*
- b. A positioning receiver 25 receiving position data and generating a position signal in response to the position data*
- c. An indicator 81, 83*
- d. A system controller 76 electrically coupled to the condition information receiver 77, the positioning system, the indicator, wherein the system controller receives the condition information signal (weather, traffic, navigation information, etc... col. 8, second paragraph), the position signal (GPS data) for conversion into a condition alert signal wherein the converted condition alert signal is received by the indicator 81, 83."*

The Office action further asserts that while "*Wiener fails to disclose overriding*

vehicle audio entertainment systems and generating an audio signal on a vehicle audio entertainment system”, “the concept of overriding the vehicle sound system such as and broadcasting emergency situation on the emergency indicator within the vehicle and de-energizing the vehicle sound system is conventional in the art as taught in Maxwell. See col. 5, lines 11-26 and col. 5, lines 48-54. In light of this teaching, it would have been obvious to one skilled in the art to apply the same concept in the system of Wiener because it would allow emergency situation to be brought to subscriber’s attention immediately.”

For independent claim 13, the Office action states that its rejection “*recites what was discussed in the rejection of claim 1*”.

Applicant respectfully disagrees with the rejection of claims 1 and 13.

First, applicant failed to locate converting the condition information signal and the position signal into a condition alert signal in Wiener. Pointing out in the Office action where in Wiener the conversion is disclosed would be helpful.

For that reason, even combined together, Wiener and Maxwell would not disclose the system claimed in claims 1 and 13 and thus would not comply with the one of the basic requirements of a *prima facie* case of obviousness (MPEP § 2143) - to teach or suggest all the claim limitations.

Additionally, there must be some suggestion or motivation to modify the reference or to combine the references. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981

(Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 USPQ at 488).

In this regard, it is noteworthy that the Maxwell patent - with its "overriding" feature so conveniently, in view of the Office action, fitting the system in the Wiener patent - was published (3 June 1997) more than three years prior to filing the Wiener application (30 January 2000). This fact notwithstanding, the Wiener patent has no suggestions whatsoever with respect to desirability of using the Maxwell's feature.

All the above considered, it is believed that the applicant's invention as claimed in claims 1 and 13 is not obvious over Wiener in view of Maxwell and patentable. Claims 2-12, 14-21, and 23-25 are believed to be patentable as directly or indirectly dependent from patentable claims 1 and 13.

For independent claim 26, the Office action asserts that "*Wiener discloses an alert system comprising a condition information receiver 70, 71, 77 receiving condition data and generating a condition information signal in response to the condition data, and an indicator. Wiener also discloses a system controller 76 electrically coupled to the condition information receiver 77, the positioning system, the indicator, wherein the system controller receives the condition information signal (weather, traffic, navigation information, etc... col. 8, second paragraph), the position signal (GPS data) for conversion into a condition alert signal wherein the converted condition alert signal is received by the indicator 81, 83.*"

The Office action further asserts that while "*Wiener fails to disclose overriding vehicle audio entertainment systems and generating an audio signal on a vehicle audio entertainment system*", "*the concept of overriding the vehicle sound system such as and broadcasting emergency situation on the emergency indicator within the vehicle and de-energizing the vehicle sound system is conventional in the art as taught in Maxwell. See col. 5, lines 11-26 and col. 5, lines 48-54. In light of this teaching, it would have been obvious to one skilled in the art to apply the same concept in the system of Wiener because it would*

allow emergency situation to be brought to subscriber's attention immediately."

For independent claim 40, the Office action states that its rejection "*recites what was discussed in claim 26 except it is a method claim*".

Applicant respectfully disagrees with the rejection of claims 26 and 40.

First, applicant failed to locate in Wiener converting the warning data and the position data into a condition alert signal, and specifically the system controller that receives the condition information signal and the position signal and converts them into a condition alert signal. Pointing out in the Office action where in Wiener this type of conversion/controller is disclosed would be helpful.

For that reason, even combined together, Wiener and Maxwell would not disclose the system claimed in claims 26 and 40 and thus would not comply with the one of the basic requirements of a *prima facie* case of obviousness (MPEP § 2143) - to teach or suggest all the claim limitations.

Additionally, there must be some suggestion or motivation to modify the reference or to combine the references. See above the arguments with regard to claims 1 and 13. There seems to be no such suggestions either in Maxwell or in Wiener.

Taking the above into consideration, it is believed that the applicant's invention as claimed in claims 26 and 40 is not obvious over Wiener in view of Maxwell and patentable. Claims 27-39, and 41-49 are believed to be patentable as directly or indirectly dependent from patentable claims 26 and 40.

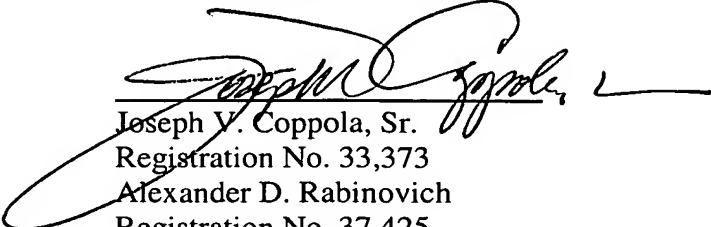
On this basis, it is believed that the 35 U.S.C. § 103(a) rejection is overcome, and applicant respectfully submits that it be withdrawn.

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IV. Conclusion

All the above considered, claims 1-50 are believed to be in condition for allowance, and this favorable action is hereby respectfully solicited.

Respectfully submitted,



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